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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,974	02/25/2004	Daniel Davitz	36008.00.0002	4118

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VEDDER PRICE KAUFMAN & KAMMHOLZ  
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CHICAGO, IL 60601

EXAMINER
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MORILLO, JANEL COMBS

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,974

Applicant(s)

DAVITZ, DANIEL

Examiner

Janelle Combs-Morillo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election with traverse of group I in the reply filed on December 20, 2004 is acknowledged. The traversal is on the ground(s) that the process claimed in group III can only be used to manufacture the silver alloy of group I. This is not found persuasive because the silver alloy product can be made by a materially different process such as powder metallurgy, etc.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Interpretation***

2. In the previous office action, claims 1-8 were objected to because claim language was confusing. The examiner stated that " $\pm 5\%$ " appeared to mean 5% relative to 29.75, or  $29.75 \pm 1.5$ , which would give a range of 28.25-31.25% Zn (rather than  $29.75\% \pm 5\%$ , which would give a range of 24.75-34.75%). This was in view of the specification at [0013]; which mentions that 5% is proportional to the weight of each component. Applicant's reply referred to the broad range of 24-34% Zn, 60-74% Cu, 0.5-1.8% Si, 0-8% Sn supported by [0012] of the specification. The amended ranges of claim 1 are not considered new matter; the examiner agrees said ranges are supported by [0012] of the specification. But the examiner could not find support for the amended ranges of claims 2 and 3: because, as stated above, the specification at [0013] details that 5% is proportional to the weight of each component, and therefore must be multiplied by each component, not added to.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. the examiner could not find support for the amended ranges of claims 2 and 3: because, as stated above, the specification at [0013] details that 5% is proportional to the weight of each component, and therefore must be multiplied by each component, not added to.

Appropriate correction is required.

	instant claim 1		net alloy		claims 4 and 7	net alloy	
	min.	max.	min.	max.		min.	max.
Ag	92.50%	95%	92.50%	95%	92.5-95%	92.50%	95%
balance an alloy comprised of:			7.50%	5%		7.50%	5%
Zn	24%	34%	2.55%	1.20%	29.75%	2.23%	1.49%
Cu	60%	74%	5.55%	3.00%	62.15%	4.66%	3.11%
Si	1%	2%	0.14%	0.03%	1.35%	0.10%	0.07%
Sn	0%	8%	0.60%	0.00%	6.75%	0.51%	0.34%

Table 1: Alloying Ranges Of (amended) Claim 1

	cl. 1	cl. 2	cl. 3	cl. 4 and 7	cl. 5	cl. 6 and 8	Eccles	Bernhard
Ag	92.5-95%	92.5-95%	92.5-95%	92.5-95%	92.5-95%	92.5-95%	preferably >92.5% Ag	89-93.5%
Balance (assumed 5-7.5%):								
Zn	1.2-2.6%	1-2.2%	1.4-2.8%	1.5-2.2%	1.2-1.8%	1.6-2.5%	0.05-5%	0.5-5%
Cu	3.0-5.6%	3.5-6.0%	3.0-5.2%	3.1-4.7%	3.7-5.6%	3.2-4.9%	0.5-6%	0.5-6%
Si	0.03-0.14%	0-0.1%	0.03-0.14%	0.07-0.10%	0.06-0.09%	0.03-0.05%	0.02-2.0%	0.02-2%
Sn	0-0.6%		0.05-0.38%	0.3-0.5%		0.05-0.07%	0.25-6%	0.25-6%
In			0-0.11%			0.06-0.09%	opt. 0.01-1.5%	0.01-1.25%
other							0.01-2.0% Ge	0.001-2% B

Table 2: Approximate Net Alloying Ranges (amended) Claims 1-8 vs. prior art

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eccles (US 6,726,877 B1) or Bernhard et al (US 5,039,479).

Eccles teaches a silver based alloy as stated in Table 2 above, which overlaps the instant net ranges of claims 1-8. Eccles teaches said alloy preferably comprises:  $\geq 92.5\%$  Ag, 2-4% Cu, 2-4% Zn, 0.25-6% Sn, 0.02-2% Si (see Eccles at claims 3, 4, 8, 10), which overlaps the presently claimed alloy composition (instant claims 1, 3, 4, 6, 7, 8).

Similarly, Bernhard teaches a Silver based alloy that overlaps the instant net alloying ranges of claims 1-8. Bernhard teaches the addition of 0.001-2% B, and Eccles teaches the addition of 0.01-2% Ge to said alloy, however, it is not clear that these additions are not excluded by the instant claim language.

Because of the overlap in alloying ranges, it is held that Eccles or Bernhard has created a prima facie case of obviousness of the presently claimed invention.

Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility.

***Response to Amendment***

7. In the response filed on December 20, 2004 applicant amended claims 1-8 and submitted various arguments traversing the rejections of record. As stated above, the examiner could not find support for the amended ranges of claims 2 and 3: because, as stated above, the specification at [0013] details that 5% is proportional to the weight of each component, and therefore must be multiplied by each component, not added to.

8. Applicant's argument that the present invention is allowable over the prior art of record because Ge and B are excluded by the instant "consisting essentially of" claim language has not been found persuasive. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). The applicant has not clearly shown that the addition of B or Ge would materially affect the basic and novel characteristics of the claimed invention (see MPEP 2111.03). Alternatively, the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.>").

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GEORGE W. SZOMIERSKI  
[REDACTED EXAMINER]

  
JCM  
March 1, 2005